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EXAMINER

LUONG, VINH

ART UNIT PAPER NUMBER

3682

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,452

Applicant(s)

MINKOW ET AL.

Examiner

Vinh T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2005 and 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).


Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment.

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1. The Amendment filed on July 12, 2005 has been entered.
2. The drawings were received on July 12, 2005. These drawings are not accepted by the Examiner because of the reasons, e.g., listed below:

(a) The drawings are not in compliance with 37 CFR 1.84. See Form PTO-948 attached;

(b) Each part of the invention such as the longitudinal midlines of the first and second tapered protrusions in claims 1 and 8 should be designated by referential numerals or characters; and

(c) The drawing corrections are inconsistent with Applicant's explanation of the changes in the remarks. See 37 CFR 1.121(d). Applicant stated on page 9 of the Amendment that Applicant proposed to add shading or cross hatching to Fig. 2. However, Applicant added the cross hatching to Fig. 3.

3. The drawings are objected to because:

(a) Each part of the invention, such as, the longitudinal midlines of the first and second tapered protrusions in claims 1 and 8 should be designated by referential numerals or characters; and

(b) The drawings are inconsistent with the specification. For example, paragraph [0043] of the specification describes that the grip 10, 20 is made of rubber or plastic. However, Fig. 2 shows that the grip is made of metal in accordance with the drawing symbols for draftsman in MPEP 608.02.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

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sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the longitudinal midline of the second tapered protrusion that is disposed generally parallel to the midline of the first protrusion in claims 1 and 8 must be shown or the features must be canceled from the claims. *No new matter should be entered.*

5. The disclosure is objected to because of the following informalities:

(a) Each part of the invention, such as, the longitudinal midlines of the first and second tapered protrusions in claims 1 and 8 should be designated by referential numerals or characters; and

(b) The specification is inconsistent with the drawings. For example, paragraph

[0043] of the specification describes that the grip 10, 20 is made of rubber or plastic. However, Fig. 2 shows that the grip is made of metal in accordance with the drawing symbols for draftsman in MPEP 608.02.

Appropriate correction is required.

6. Claim 12 is objected to because of the following informalities: the claim contains typographical error “ma+-leable.” Appropriate correction is required.

7. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “generally” in claims 1 and 8 is a relative term, which renders the claims indefinite. The term “generally” is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, it is unclear what range of angles defined by the longitudinal midlines of the first and second tapered protrusions is required so that the longitudinal midlines are considered to be “generally parallel” to each other.

It is unclear whether the term that appears at least twice such as “a longitudinal midline” in lines 10 and 13 of claim 1 refers to the same or different things. Applicant is respectfully suggested to distinguish them by numerical order, e.g., “a first longitudinal midline” and “a second longitudinal midline.”

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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9. Claims 1-5, 8-12, and 15, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Heap (US Patent No. 6,261,141 B1).

Regarding claims 1, 8, and 15, Heap teaches a handgrip 12 or 14 comprising:

a generally tubular body having a horizontal midline 46 (Fig. 6);

a first tapered protrusion 28 disposed on a forward side of the generally tubular body, on which a person's fingers can rest, the forward side generally longitudinally bisected by the horizontal midline 46 (see Attachment); and

a second tapered protrusion 26 disposed on a rear side of the generally tubular body, on which the person's palm can rest, the rear side generally longitudinally bisected by the horizontal midline 46 (Att.);

wherein the first tapered protrusion 28 has a first longitudinal midline 48 (Att.) extending between first and second ends of the first tapered protrusion, the longitudinal midline rotated at an angle 50 to the horizontal midline 46 of the generally tubular body;

wherein the second tapered protrusion 26 has a second longitudinal midline (Att.) extending between first and second ends of the second tapered protrusion 26, the second longitudinal midline (Att.) rotated at an angle to the horizontal midline 46 of the generally tubular body and disposed *generally parallel* to the first longitudinal midline (Att.) of the first tapered protrusion 28; and

wherein the first tapered protrusion 28 and the second tapered protrusion 26 reduce ulnar neuropathy by relieving tension on the person's ulnar nerve.

Claim 1 and other claims below are anticipated by Heap because Heap teaches each and every positively claimed structure. In the instant case, when the user rotates Heap's handgrip to

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row the kayak, the second longitudinal midline (Att.) is rotated therewith at an angle to the horizontal midline 46 of the generally tubular body. Moreover, Heap's handgrip is inherently useable for a motorcycle. It is well established that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art teaches all the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987). Further, the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997). In addition, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The "wherein" clause in the claims of this application merely expresses an inherent result or an intended use of the supporting mechanism, *a fortiori*, it adds nothing to claim's patentability. *Texas Instruments, Inc. v. International Trade Commission*, 26 USPQ2d 1018 (CAFC 1993).

Regarding claims 2 and 9, the first tapered protrusion 28 is positioned for accommodating the person's second, third, fourth, and fifth fingers.

Regarding claims 3 and 10, the second tapered protrusion 26 is positioned for accommodating a portion of the person's palm that lies under the person's fourth finger and fifth finger.

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Regarding claims 4 and 11, the generally tubular body includes a tapered recessed portion 32 (Fig. 3) for accommodating the person's thumb.

Regarding claims 5 and 12, the handgrip 12 or 14 is comprised of rubber as seen by drawing symbols for draftsperson in Figs. 1A, 3, 4, and 6. Rubber is a generally malleable material.

10. Claims 5-7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heap in view of Roark et al. (USP 5,823,069).

Regarding claims 5-7 and 12-14, Heap teaches the handgrip substantially as claimed. However, Heap may not explicitly teach the well-known materials, such as, rubber, plastic, or chrome.

Roark teaches the use of well known materials, such as, rubber, plastic, or chrome in order to dampen vibration and improve frictional engagement with the handgrip. See Roark, col. 1, lines 25-37, and col. 3, lines 1-9. See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use of well known materials, such as, rubber, plastic, or chrome in order to dampen vibration and improve frictional engagement with Heap's handgrip as taught or suggested by Roark.

11. Applicant's arguments filed July 12, 2005 have been fully considered but they are not persuasive.

DRAWINGS

Applicant stated that “[a]pplicant submits herewith, a redlined drawing indicating the proposed changes to Figure 2 of the drawings.” However, the replacement sheets show the changes in Figs. 3-5. The changes in Figs. 3-5 have been disapproved for the reasons set forth in paragraph 2 above.

35 USC 102

HEAP

Applicant asserted:

Applicant respectfully notes that the Heap reference does not teach first and second tapered protrusions having longitudinal midlines which are *rotated at an angle* to the midline of a generally tubular body and while have longitudinal midlines which are generally parallel to each other. In contrast, the kayak paddle of the Heap reference, generally shown in Figures 1 and 1A includes raised protrusions 12 and 14, each of which have a longitudinal axis which is generally aligned with the longitudinal axis of paddle shaft 16. In other words, neither the longitudinal axis of protrusion 12 nor protrusion 14 is rotated with respect to the longitudinal axis of paddle shaft 16. Applicant also notes that the angle 50 shown in Figure 6 of the Heap reference generally shows the vertical height or thickness of the given grip 12 or 14. Applicant further notes that angle 23 as shown in Figure 4A does not define rotations with respect to structures on individual grip 14, but instead only shows the relationship between the separate left and right hand grips 12 and 14 when attached to shaft 16 of the kayak paddle. (Emphasis added).

The Examiner respectfully submits that the longitudinal midline of Applicant’s second protrusion 26 is not rotated by itself. In fact, it is rotated only when the operator turns or rotates Applicant’s handgrip to operate the motorcycle as seen in Figs. 6 and 8. Therefore, Applicant’s recitation “the longitudinal midline (Att.) *rotated* at an angle to the horizontal midline of the

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generally tubular body” in claims 1 and 8 is “a recitation with respect to the manner in which a claimed apparatus is intended to be employed.” Therefore, it is not accorded patentable weight. *Ex parte Masham, supra*. On the other hand, Heap does teach first and second tapered protrusions having longitudinal midlines which are *rotated at an angle* to the midline of a generally tubular body as claimed. Indeed, Fig. 1 of Heap shows that when the user rows the kayak in different directions, forward, backward, or turning left or right, etc., the user inherently has to rotate the paddle, i.e., the handgrip or the longitudinal midline of Heap’s second protrusion therewith.

In addition, contrary to Applicant’s remarks, the kayak paddle of the Heap reference, generally shown in Figures 1 and 1A includes raised protrusions 28 and 26 as enlarged in Figs. 3 and 6. Each protrusion has a longitudinal axis (Att.) generally angled with the longitudinal axis 46 of paddle shaft 16. In other words, either the longitudinal axis of protrusion 28 or protrusion 26 is rotated with respect to the longitudinal axis 46 of paddle shaft 16.

The Examiner also notes that the angle 50 shown in Figure 6 of the Heap reference generally shows the vertical height or thickness of the given grip 12 or 14 and the rotation when the operator rotates the paddle.

With respect to Applicant’s statement “Applicant further notes that *angle 23* as shown in Figure 4A does not define rotations with respect to structures on individual grip 14, but instead only shows the relationship between the separate left and right hand grips 12 and 14 when attached to shaft 16 of the kayak paddle.” The Examiner cannot find the referential numeral 23 in Heap’s Fig. 4A. Thus, the Examiner cannot respond to this statement.

Given the substantial identical between Applicant's handgrip and Heap's handgrip. More important, Heap teaches each and every positively claimed element of claims 1-15, the Examiner respectfully submits that the rejections of claims 1-15 are not withdrawn.

JOHNSON

The rejection based on Johnson is withdrawn. Applicant's remarks are moot.

35 USC 103

Applicant argued that "while the Roark reference discloses in Figure 2, a grip which includes protrusions, as similar to the Heap reference the longitudinal axes of those protrusions are not rotated with respect to the center line of the tubular body."

Applicant's arguments regarding 35 USC 103 are against the references individually. The Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Roark reference is used to show the well-known materials, such as, rubber, plastic, or chrome in the handgrip art. When one forms Heap's handgrip of rubber, plastic, or chrome as taught or suggested by Roark, the modified handgrip of Heap has the longitudinal axes rotated with respect to the centerline of the tubular body when the user rotates that handgrip.

The Examiner, therefore, respectfully submits that the rejections of claims 5-17 and 12-14 are also maintained.

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12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

September 6, 2005



Vinh T. Luong
Primary Examiner

ATTACHMENT

